1617

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of	: Dollinger, H. et al	) Art Unit:	1617
Serial No.	: 09/981,025	) Examiner:	M. A. Willis
Confirmation No.	: 5630		
Filed	: 10/16/2001		
For	: Neurokinin Antagonists		
Docket No.	: 1/1154		

#5 Supp
2-5-03

Commissioner for Patents
Washington, D. C. 20231

January 16, 2003

RESPONSE TO OFFICE ACTION

Sir:

This is in response to the Office Action dated December 17, 2002, setting forth a Restriction Requirement and Election of Species Requirement.

The Restriction Requirement set forth the following two Groups:

I. Claims 1-27, drawn to compounds of formula I, process for preparing these compounds, and pharmaceutical compositions thereof. Class 514, Subclass 315

II. Claims 28-31, drawn to method of treating a neurokinin-mediated illness using the compounds of formula I. Class 514, Subclass 315

In response, Applicants hereby elect Group I (claims 1-27) with traverse.

Applicants respectfully submit that this requirement is improper and should be withdrawn. In making this requirement, the Examiner argues that the claims of Groups I and II above are distinct because "the treatment of asthma can be practiced with another materially different product such as albuterol." Although this may be true, this has no bearing on whether Groups I and II are distinct since Group II is directed to the use of the compounds of Group I, not albuterol. Thus, there is a clear link between Groups I and II in that if the compounds of Group I are determined to be patentable over the prior art, the use of those same compounds (Group II) should likewise be found patentable over the prior art. Moreover, there should not

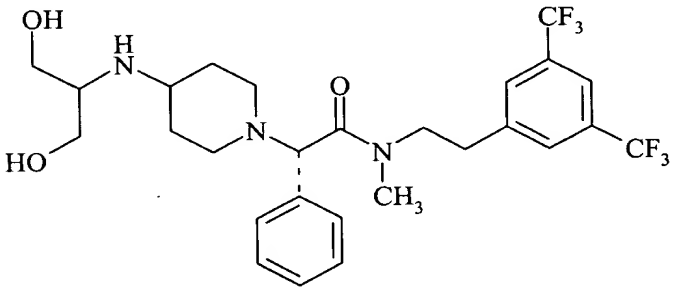
be an undue examination burden since the search required for Group I should cover the search required for Group II, ie. Class 514, Subclass 315.

Furthermore, even if the Examiner maintains this restriction requirement, Applicants submit that the USPTO's Rejoinder Practice found at MPEP 821.04 would require that the method claims of Group II be rejoined with the examination of the compound claims of Group I in the event that the compound claims are determined to be patentable, since the method claims depend from the compound claims. Accordingly, rejoinder of Group II is respectfully requested in the event that this restriction requirement is maintained.

The Election of Species requirement requires an election of a single disclosed species and an identification of the claims readable thereon.

In response, Applicant hereby elects the compound disclosed in Example 2 at page 15:

N-[2-(3,5-bis-trifluoromethyl-phenyl)-ethyl]-2-[4-(2-hydroxy-1-hydroxymethyl-ethylamino)-piperidin-1-yl]-N-methyl-2-phenylacetamide having the structural formula:



Claims 1-16 and 21-31 read upon this compound, its method of preparation, a pharmaceutical composition thereof or its method of use.

Formula (I) in claim 1 covers a "Markush" group of compounds since they all have a common core structure (a disubstituted piperidinyl core as shown in claim 1) and a common utility at neurokinin (NK) antagonists useful to treat NK-mediated illnesses. Accordingly,

Applicants submit that the USPTO's Markush Practice set forth at MPEP 803.02 should be followed in this application. That is, in accordance with such standard practice, if the elected species is found to be patentable over the prior art, the search will be extended to the non-elected species to the extent necessary to determine the patentability of the Markush-type claim. Therefore, if the elected species is found patentable, the Examiner is respectfully requested to extend the search to non-elected species covered by the claims.

Respectfully submitted,

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